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EXAMINER

LANGMAN, JONATHAN C

ART UNIT	PAPER NUMBER
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1794

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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DETAILED ACTION

This action is a supplemental action to the advisory action mailed July 14, 2009.

Response to Arguments

The amendments to the claims are entered and overcome the 112 first paragraph rejections set forth in the Final office action dated January 26, 2009.

The applicant traverses the restriction requirement set forth in the final office action.

Applicants' traversal is on the grounds that the office has not shown that there is any burden in searching the entire application. These arguments have been considered, but are not found persuasive. There is no requirement in PCT 13.1 and 13.2 of a burden in searching the entire claims to establish a *prima facie* case of a lack of unity. Applicants have made no argument that the cited references do not disclose the special technical feature or that the asserted feature is not a special technical feature.

In regards to the rejections over Pereira to Kitajima or Gonya, the applicant's arguments are not found persuasive. The applicant argues that Pereira's inventive solder may contain amounts of 0.75% max and 0.25% max of antimony and bismuth, respectively, and that the references of Kitajima and Gonya which teach amounts much higher than these maximum amounts taught by Pereira, would not have been obvious modifications.

First the Examiner would like to point out that Pereira's teaching of a solder comprising tin in an amount of less than 50% and further comprising antimony or

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bismuth, fully anticipates the claims. The applicant never claims a specific amount of bismuth or antimony, and only claims that bismuth or antimony be present in the solder.

The applicants assert that the solder compositions of Kitajima and Gonya would provide solder compositions having a higher melting point than that taught by Pereira and therefore would damage the glass in regions near the solder joint and render the solder unsatisfactory. However, it is noted that “the arguments of counsel cannot take the place of evidence in the record”, *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner’s position that the arguments provided by the applicant regarding that the solders of Gonya and Kitajima would crack the glass substrates of Pereira, must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), “the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001”.

Furthermore, the applicant argues that the solder of Pereira is taught to be used in the automotive industry, whereas the solder’s of Kitajima and Gonya are used in the electronics industry. Applicants’ are reminded that according to MPEP 2141.01 (a), a reference may be relied on as a basis for rejection of an applicants’ invention if it is “reasonably pertinent to the particular problem with which the inventor is concerned.” A reasonably pertinent reference is further described as one which “even though it maybe in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” Since Gonya and Kitajima teach the use of a known solder to connect

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conductive materials to substrates, these solders would have commended themselves to be applied to the connecting of conductors to substrates as taught by Kitajima.

For reasons of record the rejections are maintained.

JCL

/Timothy M. Speer/
Primary Examiner, Art Unit 1794